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DATE MAILED: 09/30/2004

APPLICATION NO. FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.		
09/873,829	229 05/09/2002 Yongwon Choi		600-1-200NCIP2 6562			
28977	7590 09/30/2004		EXAMINER			
MORGAN,	LEWIS & BOCKIUS I	ANDRES,	JANET L			
- / 0 - 1 - 1 - 1 - 1	PHIA, PA 19103-2921		ART UNIT	PAPER NUMBER		
•	, · · · · ·		1646			

Please find below and/or attached an Office communication concerning this application or proceeding.

		Applicat	ion No.	Applicant(s)	
		09/873,8	329	CHOI ET AL.	•
	Office Action Summary	Examine		Art Unit	
		Janet L.	Andres	1646	
	The MAILING DATE of this communi			the correspondence add	ress
Period fo		00 000 V 10 007	TO EVEIDE - 1101		
THE - Exte after - If the - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR MAILING DATE OF THIS COMMUNI nsions of time may be available under the provisions SIX (6) MONTHS from the mailing date of this comme period for reply specified above is less than thirty (30) period for reply is specified above, the maximum starte to reply within the set or extended period for reply reply received by the Office later than three months a ed patent term adjustment. See 37 CFR 1.704(b).	CATION. of 37 CFR 1.136(a). In no e- unication. D) days, a reply within the sta- statutory period will apply and v will, by statute, cause the ap-	vent, however, may a repl atutory minimum of thirty (3 will expire SIX (6) MONTH plication to become ABAN	y be timely filed 30) days will be considered timely. IS from the mailing date of this corr IDONED (35 U.S.C. § 133).	nmunication.
Status				×	
1)	Responsive to communication(s) file	d on <i>06 July 2004</i> .		•	
	·	2b)⊠ This action is i	non-final.		
3)	Since this application is in condition	for allowance excep	t for formal matters	s, prosecution as to the r	merits is
	closed in accordance with the practic	ce under <i>Ex parte Q</i>	uayle, 1935 C.D. 1	1, 453 O.G. 213.	
Dispositi	ion of Claims				
4)⊠	Claim(s) <u>1-84</u> is/are pending in the a	polication.			
	4a) Of the above claim(s) <u>9-15,26,28</u>	• •	withdrawn from c	onsideration.	
	Claim(s) is/are allowed.				
6)⊠	Claim(s) <u>1-8,16-25,27 and 37</u> is/are	rejected.			
7)	Claim(s) is/are objected to.	4			
8)[Claim(s) are subject to restric	tion and/or election i	requirement.		
Applicati	on Papers				
9)	The specification is objected to by the	e Examiner.			
	The drawing(s) filed on 4 June 2001 i		d or b) objected	I to by the Examiner.	
	Applicant may not request that any object				
	Replacement drawing sheet(s) including	the correction is requi	red if the drawing(s)	is objected to. See 37 CFF	₹ 1.121(d).
11)	The oath or declaration is objected to	by the Examiner. N	ote the attached C	Office Action or form PTC)-152.
Priority L	ınder 35 U.S.C. § 119				ſ
12)	Acknowledgment is made of a claim f	or foreian priority un	ider 35 U.S.C. & 1	19(a)-(d) or (f)	,
_	☐ All b)☐ Some * c)☐ None of:	· · · · · · · · · · · · · · · · · · ·		(a) (a) (i).	
ŕ	1. Certified copies of the priority of	documents have bee	en received.		
	2. Certified copies of the priority of	documents have bee	en received in App	lication No	
	3. Copies of the certified copies of	of the priority docum	ents have been re	ceived in this National S	tage
	application from the Internation	nal Bureau (PCT Ru	le 17.2(a)).		
* S	See the attached detailed Office action	n for a list of the cert	ified copies not red	ceived.	
Attachmen					
	e of References Cited (PTO-892) e of Draftsperson's Patent Drawing Review (P1	TO-948)	4) Interview Sum	nmary (PTO-413) fail Date	
3) 🛛 Inform	nation Disclosure Statement(s) (PTO-1449 or F r No(s)/Mail Date <u>6/02</u> .			mal Patent Application (PTO-1	152)

Election/Restrictions

Applicant's election without traverse of group I, polynucleotides, in the reply filed on 6 July 2004 is acknowledged. Claims 1-84 are pending in this application. Claims 9-15, 26, 28-36, and 38-86 are withdrawn from consideration as being drawn to a non-elected invention.

Claim Objections

Claims 25, 27, and 37 are objected to as encompassing non-elected subject matter.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims encompass mammalian cells with no requirement that they be isolated and thus encompass the host cell as it occurs in nature, for example, as a gene therapy patient. Since Applicants do not intend to claim a naturally occurring products amendment of the claims to show the hand of man would obviate this rejection. It is suggested that the claims be amended to recite "an isolated mammalian host cell ..."

Claim Rejections - 35 USC § 112

Claim 37 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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The factors to be considered have been summarized as the quantity of experimentation necessary, the amount of direction or guidance presented, the presence or absence of working examples, the nature of the invention, the state of the prior art, the relative skill of those in the art, the predictability or unpredictability of the art and the breadth of the claims. *Ex Parte Forman,* (230 USPQ 546 (Bd Pat. App. & Int. 1986)); *In re Wands,* 858 F.2d 731, 8 USPQ 2d 1400 (Fed. Cir. 1988).

This claim is drawn to a pharmaceutical composition and thus implies a therapeutic use. The specification, however, describes only general, potential effects of such a composition on p. 70. There is insufficient guidance to indicate that any biological effect could be obtained, or any disease treated, using an antagonist to TRANCE. Although the specification outlines art-recognized compositions and techniques, this is not adequate guidance as to how TRANCE inhibition could be used therapeutically, but is merely an invitation to the artisan to use the current invention as a starting point for further experimentation. Furthermore, antisense therapy is unreliable and dependent on the particular gene and particular antisense molecules used. Thus, without further guidance, it would require undue experimentation for the artisan to use antisense molecules as pharmaceutical agents.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 3, 5-8, and 16-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 2, 3, 5-8, and 16-21 encompass molecules identified by "standard hybridization conditions". No such conditions are defined in the specification; the description on pp. 39-40 does not exclude any conditions. One of skill in the art would therefore be unable to determine what conditions and thus what molecules Applicant intended the claims to encompass.

Claims 3 and 6 are also indefinite because a molecule that hybridizes to an encoding sequence will not itself encode the same protein.

Claims 22 and 23 are indefinite in the recitation of "TRANCE". There is no definition of "TRANCE"; the specification on p. 4 refers to sequences that are included but includes also analogs and derivatives, with no limitation as to their structure or function. Thus the artisan would not be able to determine what proteins, and thus what polynucleotides, Applicant intended the claims to encompass.

Claims 6 and 24 are indefinite in the recitation of "conservative variant", "analog", and "derivative". None of these terms are defined in the specification so as to require any particular structure or function; nothing is excluded by Applicant's descriptions on pp. 34 and 50. Thus the artisan would not know what molecules Applicant intended the claims to encompass.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8 and 16-23 are rejected under 35 U.S.C. 102(a) as being anticipated by

Anderson et al., Nature, 1997, vol. 390, pp. 175-179. Anderson et al. teaches a sequence
comprising SEQ ID NO: 2 with a single mismatch and teaches the sequence of SEQ ID NO: 4
with a single mismatch in figure 2a, p. 177. The polynucleotides encoding these sequences were
provided to GenBank; see footnote and attached sequences. These polynucleotides are thus
degenerate variants of SEQ ID Nos 1 and 3 according to Applicant's description on pp. 5-6.

Detectable hybridizing molecules were used in figure 2b. Protein expression is taught on p. 179.

Claims 1-8, 16-25, 27, and 37 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 6,242,213.

The '213 patent teaches SEQ ID NO 11, which is a truncated version of SEQ ID NO: 4, with a single mismatch, and SEQ ID NO: 13, which comprises SEQ ID NO: 2 with a single mismatch. Sequences encoding them, which are thus degenerate variants of Applicant's SEQ ID Nos 1 and 3, are taught in SEQ ID NOs 10 and 12. Expression is taught in column 10-14. Detectable hybridizing molecules are taught in column 9, lines 27-59. Modified antisense molecules are taught by reference to Cohen et al. in column 9, line 58.

Claims 4-8, 18-25, 27, and 37 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent 5,843,678.

The '678 patent teaches SEQ ID NO: 6, which encodes SEQ ID NO: 7, which is identical to instant SEQ ID NO: 4. See sequence alignment attached. Expression is taught in column 5.

Detectable hybridizing molecules are taught in column 4. Antisense therapy is taught in column

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NO CLAIM IS ALLOWED.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Andres whose telephone number is 571-272-0867. The examiner can normally be reached on Monday, Tuesday, Thursday, Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Janet L. Andres, Ph.D. 21 September 2004

PRIMARY EXAMINER

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encodes
#12
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LOCUS
                                 2201 bp
           AF019047
                                           mRNA
                                                   linear
                                                            PRI 22-NOV-1997
DEFINITION
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           AF019047
ACCESSION
VERSION
           AF019047.1 GI:2612921
KEYWORDS
SOURCE
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  ORGANISM
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           Eukaryota; Metazoa; Chordata; Craniata; Vertebrata; Euteleostomi;
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REFERENCE
              (bases 1 to 2201)
  AUTHORS
           Anderson, D.M., Maraskovsky, E., Billingsley, W.L., Dougall, W.C.,
           Tometsko, M.E., Roux, E.R., Teepe, M.C., DuBose, R.F., Cosman, D. and
           Galibert, L.
           A homologue of the TNF receptor and its ligand enhance T-cell
  TITLE
           growth and dendritic-cell function
  JOURNAL
           Nature 390 (6656), 175-179 (1997)
  MEDLINE
           98032977
  PUBMED
           9367155
              (bases 1 to 2201)
REFERENCE
  AUTHORS
           Anderson, D.M., Billingsley, W., Dougall, W., Maraskovsky, E.,
           Cosman, D., DuBose, R. and Galibert, L.
  TITLE
           Direct Submission
           Submitted (13-AUG-1997) Molecular Biology, Immunex Corp., 51
  JOURNAL
           University St., Seattle, WA 98101, USA
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             Db
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enco des
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             Galibert.L.
   TITLE
             A homologue of the TNF receptor and its ligand enhance T-cell
             growth and dendritic-cell function
   JOURNAL
             Nature 390 (6656), 175-179 (1997)
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 REFERENCE
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   AUTHORS
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             Cosman, D., DuBose, R. and Galibert, L.
             Direct Submission
   TITLE
   JOURNAL
             Submitted (13-AUG-1997) Molecular Biology, Immunex Corp., 51
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Qу

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Qу	546	GCCACAGCGCTTCTCAGGAGCTCCAGCTATGATGGAAGGCTCATGGTTGGATGTGGCCCA	605
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Qy	726	CTCTAACATGACGTTAAGCAACGGAAAACTAAGGGTTAACCAAGATGGCTTCTATTACCT	785
Db	721	CTCTAACATGACGTTAAGCAACGGAAAACTAAGGGTTAACCAAGATGGCTTCTATTACCT	780
Qy	786	GTACGCCAACATTTGCTTTCGGCATCATGAAACATCGGGAAGCGTACCTACAGACTATCT	845
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Qу	1026	TTCCCTGCTGGATCCGGATCAAGATGCGACGTACTTTGGGGCTTTCAAAGTTCAGGACAT	1085
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Qу	1563	TGTATTTTATATATGTCTAAAGTTATATTTCAGGTGTAATGTTTTCTGTGCAAAGTTT	1622
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Qу	1623	TGTAAATTATATTTGTGCTATAGTATTTGATTCAAAATATTTAAAAATGTCTCACTGTTG	1682
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 AUTHORS
         Boyle, W.J.
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Db		TTCATGGTGATTACAACGGTTTTACAATTTTGTAATGATTTCCTAGAATTGAACCAGA	
Qу		TTGGGAGGGTATTCCGATGCTTATGAAAACTTACACGTGAGCTATGGAAGGGGGTCAC	
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Qy	1455	ATGTCATTGCATAGAAATGATAGTGTGAAGGGTTAAGTTCTTTTGAATTGTTACATTGCG	1514
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Qy	1515	CTGGGACCTGCAAATAAGTTCTTTTTTTCTAATGAGGAGAAAAATATATGTATTTTTA	1572
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Qу	1753	TAGCTAAGGGGGCAGAATACTGTTTCTGGTGACCACATGTAGTTTATTTCTTT	1812
Db	1771	TAGCTAAGGGGGCAGAATACTGTTTCTGGTGACCACATGTAGTTTATTCTTTATTCTTT	1830
Qу	1813	TTAACTTAATAGAGTCTTCAGACTTGTCAAAACTATGCAAGCAA	1872
Db	, 1831	TTAACTTAATAGAGTCTTCAGACTTGTCAAAACTATGCAAGCAA	1890
Qу	1873	TAAAATGAATACCTTGAATAATAAGTAGGATGTTGGTCACCAGGTGCCTTTCAAATTTAG	1932
Db	1891	TAAAATGAATACCTTGAATAATAAGTAGGATGTTGGTCACCAGGTGCCTTTCAAATTTAG	1950
Qу	1933	AAGCTAATTGACTTTAGGAGCTGACATAGCCAAAAAGGA-ACATAATAGGCTACTGAAAT	1991
Db	1951	AAGCTAATTGACTTTAGGAGCTGACATAGCCAAAAAGGATACATAATAGGCTACTGAAAT	2010
Qу	1992	CTGTCAGGAGTATTATGCAATTATTGAACAGGTGTCTTTTTTTACAAGAGCTACAAATT	2051
Db	2011	CTGTCAGGAGTATTTATGCAATTATTGAACAGGTGTCTTTTTTTACAAGAGCTACAAATT	2070
Qу	2052	GTAAATTTTGGTTTCTTTTTTTCCCATAGAAAATGTACTATAGTTTATCAGCCAAAAA	2111
Db	2071	GTAAATTTT-GTTTCTTTTTTTCCCATAGAAAATGTACTATAGTTTATCAGCCAAAAAA	2129
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QУ		AFQGAVQKELQI								
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Qy		DQDATYFGAFK\	ĨIII							
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